

REMARKS/ARGUMENTS

Claims 1-4, 6-21, 23-60, and 62-80 are pending. Applicants submit that independent Claims 1, 19, 35, 46 and 57 are currently distinguishable from the cited references. In view of the following remarks, Applicants respectfully request reconsideration and allowance of the claims. It is believed that the pending claims define patentable subject matter over the references cited by the Examiner and notice to such effect is requested at the Examiner's earliest convenience.

The Examiner rejects Claims 1-4, 6-21, 23-56, and 56 under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 5,738,159 to O'Brien ("O'Brien") in view of U.S. Patent No. 3,487,875 to Shukat *et al.* ("Shukat"). In addition, the Examiner rejects Claims 57-60, 62-75, and 77-80 under 35 U.S.C. §103(a) as being obvious over O'Brien in view of Shukat and further in view of U.S. Patent No. 6,563,516 to Hwang.

Independent Claims 1, 19, 35, 46 and 57 recite that the panel or window treatment, when raised, forms a series of predetermined **horizontally stacking pleats free of ballooning, billowing and scalloping**. Moreover, independent Claims 1, 19, and 46 recite that the guide elements define vertically spaced fold lines to form predetermined **horizontally stacking pleats** when the panel is raised, wherein **the length of the pleats are substantially parallel to the top of the panel**. Thus, the claimed raisable window treatment of the present application is fundamentally and structurally distinct from O'Brien and there is no motivation or suggestion to modify O'Brien to include the slats of Shukat, as such a configuration would render O'Brien unsuitable for its intended purpose.

More particularly, and contrary to the Examiner's assertions, O'Brien does not disclose "features other than potential ballooning or scalloped shapes." As shown in Figures 12, 14, 17 and 20, the various "selectively adjustable appearances" disclosed in O'Brien are limited to: (1) a scalloped "Austrian Drape" (*see* O'Brien, column 3, lines 21-22); (2) a "balloon drape" (*see* O'Brien, column 3, lines 23-34); and a "a genuine tab drape" (*see* O'Brien, column 7, lines 33-34 and Figures 17 and 20). No additional configurations or embodiments are disclosed. Furthermore, the "genuine tab drape" disclosed by O'Brien with reference to Figures 17 and 20 is not a "raisable panel" as specifically recited by the claimed invention.

Significantly, the proposed modification of the window drape of O'Brien with the addition of straight "stiffening members" (as generally disclosed in Shukat) would render the O'Brien window drape unsatisfactory for achieving the various indicated styles of O'Brien (such as the gathered, scalloped, and billowing styles disclosed in O'Brien with respect to Figures 12, 14, 17 and 20). Moreover, the addition of lateral "stiffening members" would also prevent the operation of the O'Brien window drape as a "genuine tab drape," which opens by laterally gathering the drape on one side of a window. Consequently, as a matter of law, there can be no suggestion or motivation to modify O'Brien with the stiffening members of Shukat to obtain the claimed invention as is required to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a).

Furthermore, O'Brien teaches away from including slats or "stiffening members" in the disclosed "selectively adjustable" window drape, in that the scalloped features shown in Figure 12, for example, could not be achieved. Indeed, the Federal Circuit has held that "if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." See MPEP §2143.01, citing *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). O'Brien states that "it is a primary object of the present invention... to provide a window drape capable of being selectively arranged to achieve different styles." See O'Brien, column 1, lines 51-54. Applicants respectfully submit that modification of the window drape of O'Brien with the addition of straight "stiffening members" (as generally disclosed in Shukat) would render the O'Brien window drape unsatisfactory for achieving different styles (such as, for example, the gathered, scalloped, and billowing styles disclosed in O'Brien with respect to Figures 12 and 14).

Furthermore, the Federal Circuit has consistently stated that a finding of obviousness requires a specific teaching, motivation, or suggestion to combine the teachings of individual items of prior art. See *In re Fine*, 337 F.2d 1071, 1075 (Fed. Cir. 1988). In fact, the Court of Appeals for the Federal Circuit has stated that, "[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight." *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999). Although the evidence of a suggestion, teaching, or motivation to combine the references commonly comes from the prior art references

themselves, the suggestion, teaching, or motivation can come from the knowledge of one of ordinary skill in the art or the nature of the problem to be solved. *Id.* In any event, the showing must be clear and particular and “[b]road conclusory statements regarding the teaching effect of multiple references, standing alone, are not ‘evidence.’” *Id.* Although the Court in *KSR Int’l Co. v. Teleflex Inc.* found that the teaching, suggestion, and motivation test should not be rigidly applied, some teaching, suggestion, or motivation and a reasonable expectation of success are needed in order to properly combine references. *See* MPEP §2143 (citing *KSR*, 550 U.S. ___, 82 USPQ2d, 1385 (2007)).

Instead of providing a motivation to combine the teachings of O’Brien and Shukat, O’Brien teaches away from including slats or “stiffening members” in the disclosed window drape, since O’Brien discloses a “window drape capable of being selectively arranged to achieve different styles” (*see* O’Brien, column 1, lines 53-54). More particularly, the window shade disclosed in O’Brien is disclosed as being capable of forming an “Austrian style drape” wherein the face panel is adjusted to “be gathered upwardly,” not horizontally pleated as required in the pending claims. *See* O’Brien, column 6, lines 43-63 and Figure 12. Furthermore, the window drape of O’Brien is further disclosed as being capable of forming a “balloon shade” wherein the lower end of the face panel is “gathered upwardly into a gently scalloped, billowing shape as shown in FIG. 14.” *See* O’Brien, column 7, lines 1-11 and Figure 14. The slats or “stiffening members” (52, 54) disclosed generally by Shukat; in contrast, serve “to prevent curling and wrinkling of the sheet member.” *See* Shukat, column 3, lines 53-54 (emphasis added). Thus, the slats or “stiffening members” disclosed by Shukat, would prevent the “upward gathering” and “scalloped, billowing shapes” or other “curling and wrinkling” shown in Figures 12 and 14 of O’Brien, if added to the window drape of O’Brien. Similarly, the disclosed drape configurations of O’Brien teach away from horizontally stacking pleats and guide elements that define vertically spaced fold lines to form predetermined horizontally stacking pleats when the panel is raised, wherein the length of the pleats are substantially parallel to the top of the panel as recited by the claimed invention.

Thus, Applicants respectfully submit that there is no suggestion or motivation to modify the O’Brien window shade with the addition of the slats generally disclosed in Shukat. Therefore, the rejection under §103(a) is overcome. In addition, Applicants submit that each of

the dependent claims depend from and further patentably distinguish a respective independent claim and are allowable for at least those reasons discussed above.

CONCLUSION

In conclusion, none of the cited references discloses the claimed invention. Accordingly, in view of the above differences between the Applicants' invention and the cited references, Applicants submit that the present invention, as defined by the pending claims, is patentable over the references cited in the Office Action. As such, for the reasons set forth above, Claims 1-4, 6-21, 23-60, and 62-80 are believed to be in condition for immediate allowance and notice to such effect is respectfully requested at the Examiner's earliest opportunity.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR §1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



Trent A. Kirk
Registration No. 54,223

Customer No. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Tel Raleigh Office (919) 862-2200
Fax Raleigh Office (919) 862-2260

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